



#9
mDS
11-26-03

Docket No.: 1293.1218

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Un-jin CHOI et al.

Serial No. 09/884,421

Group Art Unit: 2651

Confirmation No. 9921

Filed: June 20, 2001

Examiner: Castro, Angel A.

For: DISK CARTRIDGE AND DISK RECORDING REPRODUCING APPARATUS

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

RECEIVED

NOV 21 2003

Commissioner for Patents
P.O. Box 1450
Washington, D.C. 20231

Technology Center 2600

Sir:

In the Office Action dated October 20, 2003, an election of species requirement was made between the following allegedly patentably distinct species:

- Species 1, drawn to FIG. 4;
- Species 2, drawn to FIG. 13A;
- Species 3, drawn to FIG. 13B;
- Species 5, drawn to FIG. 14A
- Species 5, drawn to FIG. 14B; and
- Species 6, drawn to FIG. 15.

In order to comply with the requirements of 37 CFR § 1.146, and MPEP §809.02(a), Applicant provisionally elect, with traverse, to prosecute the species of Group I. It is respectfully submitted that at least claims 1-5, 34, and 39-44 read on the elected species.

Applicants submit that the election of species requirement is not well founded. A careful review of the subject application reveals that the various embodiments are so closely related as to not require separate fields of search. Accordingly, neither Applicants nor the U.S. Patent and Trademark Office should be put through the trouble and expense entailed in multiple filing and prosecution. In addition, Applicants submit that the public-at-large should not be required to obtain and study several patents in order to have available all of the issued patent claims covering the invention.

Also, contrary to the contention that there are no generic claims pending, Applicants respectfully submit that independent claim 34 is generic to all six alleged species.

Further, the making of an election species is not mandatory in all instances where it is possible to do so. Rather, the Examiner may use his/her discretion and choose not to make an election of species where circumstances warrant. It is believed that such is the case in the subject application. Therefore, Applicants request, under 37 C.F.R. § 1.143, that the Examiner reconsider and withdraw the election requirement set forth in the above-noted Office Action.

Still further, even if the Examiner declines to exercise his/her discretion to withdraw the election requirement in its entirety, Applicants request that the Examiner reconsider the contention that six alleged species are present in the subject application. For example, it is respectfully submitted that alleged Species 2 and 3 are so closely related as to not require separate fields of search. Similarly, it is respectfully submitted that alleged Species 3 and 4 are also so closely related as to not require separate fields of search. Indeed, it is respectfully submitted that claims 6, 7, 10-12, 20, 21, 23-25, 35, 42, and 45 are generic to Species 2-5. Therefore, Applicants request, under 37 C.F.R. § 1.143, that the Examiner reconsider and modify the election requirement set forth in the above-noted Office Action.

Applicants further submit that the instant application is in condition for allowance. Favorable consideration and early passage to issue are requested.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 11/20/03

By: Michael E. Kondoudis
Michael E. Kondoudis
Registration No. 42,758

1201 New York Avenue, NW, Ste. 700
Washington, D.C. 20001
Telephone: (202) 434-1500
Facsimile: (202) 434-1501